

RECEIVED
CENTRAL FAX CENTER

MAY 14 2010

REMARKS/ARGUMENTS

In view of the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before issuing any further action on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 103

Claims 1-6, 8, 10-12, 15-18, 34-38, 40-42, 45-52, 54, 56-58, 61-64, 80-88, 91 and 92 are rejected under 35 U.S.C. § 103 as being unpatentable over International Publication No. WO 02/25507 ("the Werkhoven publication") in view of U.S. Patent Application Publication No. 2003/0026231 ("the Lazaridis publication"). The applicants respectfully request that the Examiner withdraw this ground of rejection in view of the following.

Independent claim 1 (and similarly, independent claims 34, 40, 45, 47, 80, 86 and 91) is not rendered obvious by the Werkhoven and the Lazaridis publications

at least because the cited references do not teach or make obvious a combination of (1) **generating, by the web-based e-mail serving system, a first ad request for at least one ad relevant to the e-mail content, the first ad request including information of the e-mail content and a request identifier**, (2) **transmitting, by the web-based e-mail serving system, the first ad request to a content-relevant ad serving system**, (3) **receiving, responsive to the transmitted first ad request and by the web-based e-mail serving system, at least one ad relevant to the e mail content in association with the request identifier from the content-relevant ad serving system**, in combination with other features of claim 1.

First, in rejecting claims 1, 34, 40, 45, 47, 80, 86 and 91, the Examiner concedes that the Werkhoven publication fails to disclose the foregoing features. The Examiner relies on items 10 a, b, c, and 18 of Figure 1, Figure 2, paragraphs [0015], [0016], [0021], [0029], [0050] and [0054] of the Lazaridis publication to address this deficiency. (See Paper No. 20100207, pages 3 and 4.) The applicants respectfully submit that the Lazaridis publication does not teach or make obvious these features.

More specifically, the Figures 1 and 2 of the Lazaridis publication are block diagrams for "pushing information to a mobile device from a Proxy Content Server." (Paragraph [0006] of the Lazaridis publication) This information is delivered to the mobile device users based on users' channel preference when they "select or de-select content". (Paragraph [0050] of the Lazaridis publication) With regard to advertisements, the Lazaridis publication states, in pertinent part:

[0021] The Proxy Content Server 18 may be implemented in several ways and one embodiment is shown in FIG. 1. In this illustration, the Proxy Content Server 18 has advertising channels 21a, content channels 21b and general advertising channels 21c. *If advertisers have a preference for their advertisements to be included with a particular type of content channel, then all advertisements go into the corresponding channel for that content. If advertisers do not have a preference, then the general advertising channel 21c is used and it is applied across all content channels 21b equally.* For example, a company offering financial services may advertise in the stock quotes and financial content channel, while advertising for new movies may be applied across all content channels equally.

[0035] *Content channels are separated by tags provided by the Proxy Content Server 18,* and therefore match what has been provided and configured on the Proxy Content Server 18. This allows for dynamic additional channels to be added on the Proxy Content Server 18 and the content database 50 on the mobile device 24 mirrors those content channels. Each time a new channel is added, the advertising and information software module 42 will dynamically create a new database entry for the new channel. There is also a master list of all content channels that is presented to the user when they are selecting between channels. This is also true for advertising channels, which in most situations match the content channels. Thus *each time a new tag is received, including channel name, identifier and other size and configuration information, a new advertising and/or content channel appears for the user to access.* The user can then choose to discontinue data flow into that channel, or accept data into that channel based on their interests.

[0052] If the user chooses to view all data from a given channel (step 92), then the content information is presented to the user in a manner compatible with the

mobile device 24. As the information viewed and scanned, the Channel Viewer and Selector module 45 monitors the information for meta tags within the content screen at step 93. *If a meta tag is detected, then at step 94 the Channel Viewer and Selector module accesses the Channel Content database to match the tag. During this process, the Channel Viewer and Selector module 45 determines whether there is any dynamic advertising content 52B that matches the meta tag at step 94. If dynamic advertising content 52B exists, then the Channel Viewer and Selector module 45 combines the dynamic advertising content 52B and static advertising content 52A in step 96, and presents it to the user on the device's display 44 in step 98. If no dynamic advertising content 52B exists, however, then the Channel Viewer and Selector module 45 combines the static advertising content 52A with the default advertising content 52C for display to the user in step 100. This combined information is then presented to the user in the location specified by the meta tag at step 98.* After the information is displayed to the user at step 98, the mobile device user remains in the Channel Viewer and Selector module 45 unit exiting the software application, and the method continues at step 85. [Emphasis added.]

(Paragraphs [0021], [0035] and [0053] of the Lazaridis publication)

Thus, in the Lazaridis publication, advertisers select specific advertisement channels to run their advertisements (or in general, across all channels). (See channels 21a, 21b of Figure 1 and paragraph [0021] of the Lazaridis publication.) That is, the Lazaridis publication selects ads based on a selected **user channel**. This is very different from using **information of the e-mail content** to obtain ads relevant to such email content as claimed. In the Lazaridis publication, the request for ads would not need or use email content information.

Second, the Examiner applies the art of record inconsistently as teaching the **request identifier** recited in claim 1. Specifically, the Werkhoven publication discloses:

a control element, which, on opening of the electronic mail, triggers the events leading to the display of the pop-up window displaying the push-content material.

(Page 3, lines 12-15 of the Werkhoven publication) The Examiner contends that this "control element in the form of a tag" (Page 3, lines 30-35, executable code in an email which is triggered when a user opens the email.) teaches the claimed "request identifier" in elements of claim 1. (See Paper No. 20100207, pages 3 and 4.) In this regard, claim 1 recites, in pertinent part:

- b) generating, by the web-based e-mail serving system, **a request identifier**;
- c) serving to a client device, by the web-based e-mail serving system, the requested document in association with **the request identifier**;
- d) generating, by the web-based e-mail serving system, a first ad request for at least one ad relevant to the e-mail content, the first ad request including information of the e-mail content and **the request identifier**;
- e) transmitting, by the web-based e-mail serving system, the first ad request to a content-relevant ad serving system;
- f) receiving, responsive to the transmitted first ad request and by the web-based e-mail serving system, at least one ad relevant to the e-mail content in association with **the request identifier** from the content-relevant ad serving system;
- g) storing, by the web-based e-mail serving system, the received at least one ad in association with **the request identifier**;

- h) accepting, by the web-based e-mail serving system, a second ad request from the client device, the second ad request including *the request identifier*;
- i) reading, by the web-based e-mail serving system, the stored at least one ad using *the request identifier* included in the second ad request; and
- j) serving to the client device, by the web-based e-mail serving system, the at least one ad read. [Emphasis added.]

However, in relying on the Lazaridis publication, the Examiner contends that the user channel preference (manually selected at the user device) corresponds to the claimed "request identifier." Clearly, the user channel preference in the Lazaridis publication is **incompatible** with the tag discussed in the Werkhoven publication -- one concerns executable code triggered when an email is opened, while the other concerns a channel identifier.

Finally, the Office Action fails to establish the proper obviousness rationale. Specifically, the Examiner states:

the claimed invention is a **combination of old elements** and in the combination each element would have performed the **same function** as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were **predictable** [Emphasis added.].

(Paper No. 20100207, page 5) The Examiner's obviousness rationale is apparently that he is combining prior art elements according to known methods to yield predictable results, alleging that the channel preference of the Lazaridis publication was applied to the Werkhoven publication **without any changes to its function**. (See

Paper No. 20100207, pages 3-5.) However, under this rationale, the Examiner must articulate:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference, (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, **and that in combination, each element merely would have performed the same function as it did separately,** (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable, and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. [Emphasis added.]

(M.P.E.P. § 2143; See also, "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," OG Notices 06 Nov 2007.) However, the applicants have just demonstrated that the user channel preference in the Lazaridis publication is **incompatible** with the tag discussed in the Werkhoven publication. That is, the Examiner has not supported a proper rationale to establish obviousness of the rejected claims.

Independent claim 1 is not rendered obvious by the Werkhoven and Lazaridis publications for at least the foregoing reasons. Independent claims 34, 40, 45, 47, 80, 86 and 91 are similarly not rendered obvious by the cited publications. Since claims 2-6, 8, 10-12 and 15-18 directly or indirectly depend from claim 1, since claims 35-38 depend from claim 34, since claims 41 and 42 depend from claim 40, since claim 46 depends from claim 45, since claims 48-52, 54, 56-58 and 61-64 directly or indirectly depend from claim 47, since claims 81-85 depend from claim 80, since claims 87 and 88 depend from claim 86 and since claim 92 depends from claim 91, these claims are similarly not rendered obvious by the cited publications.

Rejections under 35 U.S.C. § 102

Independent claims 93 and 94 stand rejected under 35 U.S.C. § 102 as being anticipated by the Werkhoven publication. Independent claim 93 claims a computer-implemented method for facilitating the serving of advertisements with e-mail content. Independent claim 94 claims an apparatus with similar corresponding features.

Independent claim 93 is not anticipated by the Werkhoven publication at least because the Werkhoven publication does not teach obtaining, ***by the web-based e-mail serving system, at least one ad relevant to the e-mail content, the at least one ad having been determined automatically using at least some of the e-mail content***, in combination with other features of claim 93.

In rejecting claim 93, the Examiner contends that the passage from page 3, lines 1-37 of the Werkhoven publication teaches the aforementioned features. (See Paper No. 20100207, pages 9 and 10.) The applicants respectfully disagree.

Page 3 of the Werkhoven publication states that "[d]ifferent push-content material may be displayed on each opening of the electronic mail." (Page 3, lines 18 and 19 of the Werkhoven publication) Although these push-content material may be associated with "electronic mails from a user's car dealer to inform them that a service is required on their car" to their mailing list (Page 9, lines 2-5 of the Werkhoven publication), the Werkhoven publication does not teach that those push-content material are determined based on the e-mail content as claimed. Thus, claim 93 is not anticipated by the Werkhoven publication for at least this reason. Claim 94 is not anticipated by the Werkhoven publication for similar reasons.

Conclusion

In view of the foregoing remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

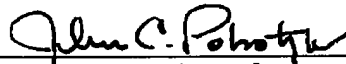
Any arguments made in this request for reconsideration pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to

seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

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